REMARKS

In the Office Action dated March 1, 2005, the Examiner requested changes to the specification; objected to claims 28-88; rejected claims 62-88 under 35 U.S. C. § 112, second paragraph; rejected claims 28-33, 37-41, 43-51, and 53-61 under 35 U.S.C. § 103(a) as being unpatentable over *Boutcher* (U.S. Patent No. 5,915,112) in view of *Hudetz et al.* (U.S. Patent No. 5,978,773); and rejected claims 34-36, 42, and 52 in view of *Boutcher* in view of *Hudetz et al.*, in further view of *Hart* (U.S. Patent no. 6,363,409).

By this amendment, Applicants have amended claims 62, 71, 75, 78, 80, 81, and 85. Based on these amendments and the following remarks, Applicants respectfully traverse the objections and rejections presented in the Office Action.

I. Request for Consideration of Previously Filed Information Disclosure Statements

Applicants note that the Examiner has not provided an initialed copy of the Form PTO 1449 that accompanied the Information Disclosure Statement (IDS) filed on September 3, 2002. Applicants also filed an IDS on February 24, 2005. Applicants respectfully request that the Examiner consider the references listed on the Forms PTO 1449 and PTO/SB/08 and provide Applicants with a signed copy of the forms that accompanied all IDS's filed in this application.

Enclosed herewith is a copy of the IDS's, Forms PTO 1449 and PTO/SB/08, and stamped postcards establishing receipt by the Office of the IDS and cited references on February 24, 2005 and September 3, 2002.

II. The U.S. Patent Applications Referenced in Applicants' Specification

Applicants have amended the specification to include the Application Serial Nos.

and corresponding filing dates for the U.S. Patent Applications referenced in this

application.

III. The Objections to claims 28-88

The Examiner objects to the claims because "[c]laim 28 recites 'comprising the

steps of.'" The Examiner further asserts "[t]here is insufficient antecedent basis for [the]

above language." Moreover, the Examiner states "[c]laims 29-88 include the same

language and are objected to for the same reason" and suggests Applicants remove all

references to "steps" from claims 28-88. Applicants disagree with the Examiner's

objection for the following reasons.

First, the phrase "comprising the steps of" is not an ambiguous phrase and does

not lack antecedent basis. This phrase is commonly used in presenting method claims;

a practice followed for many years. The phrase sets up the preamble of a method claim

that properly follows with a sequence of steps that form the claimed method. In context,

the method claims recite: "A method . . . comprising the steps of." Applicants refer the

Examiner to M.P.E.P. § 2173.05(e), which states,

> [a] claim is indefinite when it contains words or phrases
> whose meaning is unclear. The lack of clarity could arise
> where a claim refers to "said lever" or "the lever," where the
> claim contains no earlier recitation or limitation of a lever and
> where it would be unclear as to what element the limitation
> was making reference. Similarly, if two different levers are
> recited earlier in the claim, the recitation of "said lever" in the
> same or subsequent claim would be unclear where it is

uncertain which of the two levers was intended. A claim
which refers to "said aluminum lever," but recites only "a
lever" earlier in the claim, is indefinite because it is uncertain
as to the lever to which reference is made. ***Obviously,
however, the failure to provide explicit antecedent basis
for terms does not always render a claim indefinite. If
the scope of a claim would be reasonably ascertainable
by those skilled in the art, then the claim is not
indefinite.*** Ex parte Porter, 25 USPQ2d 1144, 1145 (Bd.
Pat. App. & Inter. 1992) ("controlled stream of fluid" provided
reasonable antecedent basis for "the controlled fluid").
Inherent components of elements recited have antecedent
basis in the recitation of the components themselves. For
example, the limitation "the outer surface of said sphere"
would not require an antecedent recitation that the sphere
has an outer surface. >See Bose Corp. v. JBL, Inc., 274
F.3d 1354, 1359, 61 USPQ2d 1216, 1218-19 (Fed. Cir 2001)
(holding that recitation of "an ellipse" provided antecedent
basis for "an ellipse having a major diameter" because
"[t]here can be no dispute that mathematically an inherent
characteristic of an ellipse is a major diameter").

(Emphasis Added.)

Second, contrary to the Examiner's assertions, the phrase "comprising the steps

of" is not present in all of claims 28-88. For example, claims 44 and 45 are directed to

systems and make no reference to a method.

Because the phrase "comprising the steps of" does not render the claim indefinite

and not all of claims 28-88 include the phrase, Applicants respectfully request the

Examiner withdraw the objection.

IV. The Rejection of Claims 62-88 under 35 U.S.C. § 112, Second Paragraph

The Examiner rejects claims 62-88 under 35 U.S.C. § 112, second paragraph. In

particular, the Examiner asserts "transforming parameters into different types for

subsequent transmission" is indefinite. While Applicants disagree with the Examiner,

Applicants have amended claims 62, 71, 75, 78, 80, 81, and 85 to clarify the

"parameters" recited in these claims. Because these amended claims are not indefinite, Applicants request the rejection of claims 62-88 under 35 U.S.C. § 112, second paragraph be withdrawn, and the claims allowed.

Further, Applicants traverse the Examiner's assertion that the rejection of claims 62-88 under 35 U.S.C. § 112, second paragraph, precludes examination of these claims in view of the prior art. As noted above, Applicants do not subscribe to the Examiner's position that these claims lack antecedent basis and are indefinite. Accordingly, the amendments of claims 62, 71, 75, 78, 80, 81, and 85 do not constitute a waiver of Applicants' rights to traverse any procedural and/or substantive arguments presented by the Examiner regarding the possible future application of prior art to these claims.

V. The Rejection of Claims 28-33, 37-41, 43-51, and 53-61 under 35 U.S.C. § 103(a)

The Examiner rejects claims 28-33, 37-41, 43-51, and 53-61 under 35 U.S.C. § 103(a) as being unpatentable over *Boutcher* (U.S. Patent No. 5,915,112) in view of *Hudetz et al.* (U.S. Patent No. 5,978,773). Applicants traverse these rejections because the Examiner has failed to establish a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. *See* M.P.E.P. § 2143. Third, a reasonable expectation of success must exist. *See*

M.P.E.P. § 2143.02. Moreover, each of these requirements must "be found in the prior

art, and not based on applicant's disclosure." M.P.E.P. § 2143. Applicant traverses the

rejection of claims 1-6, 9, 10, 12, and 13 because the Examiner failed to establish a

prima facie case of obviousness.

<u>a.</u>   The Cited Art Does Not Teach or Suggest the Recitations of Claims 28-33, 37-41, 43-51, and 53-61, as Asserted by the Examiner

In rejecting Claims 28, 37, 44-46, and 55, the Examiner asserts *Boutcher*

discloses a lookup service in the form of a network directory to allow access to a

network service in the form of server 20. (*See Office Action,* page 4, line 22 to page 5,

line 1.) The Examiner further asserts that *Boutcher* discloses a client dynamically

loading executable code to facilitate access to server 20 via server stub 44 and routines

A and B. (*See Office Action*, page 5, lines 1-3.) Applicants disagree with the

Examiner's interpretation of *Boutcher*. *Boutcher* may disclose server and client stubs,

and those stubs may enable the client and server 20 to package and process client

requests. However, *Boutcher* does not disclose or suggest dynamically loading

executable code to facilitate access to a network service, as asserted by the Examiner.

On the contrary, *Boutcher* uses stubs for processing remote procedure interfaces that

are programmed in the client and server 20 to facilitate transmission of information

between the two systems. *Boutcher* uses a version map to assist compatibility between

procedure routines among the client and server 20. (*See Boutcher*, col. 8, lines 23-41.)

Indeed, *Boutcher* states that the version map is "preferably resident in the client stub."

(*Id.,* col. 8, lines 35-36.) Accordingly, contrary to the Examiner's assertions, *Boutcher*

does not show a client that may dynamically load executable code to facilitate access to

server 20 because, for example, the version map and client stub is resident in the client prior to performing a remote procedure call.

Moreover, the Examiner contradicts the position that *Boutcher* discloses a client that may dynamically load executable code to facilitate access of a network service in admitting that the reference does not disclose "returning a resource locator to the client from the lookup service." (*See Office Action,* page 5, lines 3-4.) Claim 28 recites, among other things, "returning a resource locator to the client from the lookup service *so that the client may dynamically load executable code to facilitate access of the one network service."* (Emphasis added.) Claim 37 recited, among other things, "receiving, responsive to the request, by the client from the lookup service, *a resource locator to dynamically load executable code to facilitate access of the one service."* (Emphasis added.) Claim 44 recites, among other things, "a client computer with a program that sends a request to the lookup service for the one network service, that receives the resource locator from the server computer, and *uses the resource locator to dynamically load executable code to facilitate access of the one network service."* (Emphasis added.) Claim 45 recites, among other things, "means for returning a resource locator to the client from the lookup service *such that the client may dynamically load executable code to facilitate access of the one network service."* (Emphasis added.) Claim 46 recited, among other things, "returning a resource locator to the client from the lookup service *so that the client may dynamically load executable code to facilitate access of the one network service."* (Emphasis added.) And, claim 55 recites, among other things, "receiving, responsive to the request, by the client from the lookup service, *a resource locator to dynamically load executable code to facilitate access of the one*

service." (Emphasis added.) Because, as admitted by the Examiner, *Boutcher* does not disclose "returning a resource locator to the client," the reference further fails to disclose or suggest doing such that the client may dynamically load executable code to facilitate access of the one network service, as recited in claims 28 37, 44-46, and 55.

In addressing the deficiencies of *Boutcher*, the Examiner asserts *Hudtz et al.* discloses "returning a resource locator to the client from the lookup service." (*See Office Action*, page 5, lines 4-5.) Applicants disagree with the Examiner's interpretation of *Hudtz et al.*

Hudtz et al. discloses a system for correlating Uniform Product Code (UPC) labels to Uniform Resource Locators (URLs) (i.e., Internet network addresses.) (*See* Abstract.) According to *Hudtz et al.*, the system allows a user to manually enter a UPC via a Web browser. The system locates URLs associated with the UPC and displays the results in a table, such as table 60 shown in Fig. 4 of *Hudtz et al.* The Examiner relies on Fig. 4, and in particular, the URLs 74 listed in table 60, to suggest the reference discloses returning a resource locator to a client. The URLs displayed by *Hudtz et al.* may be resource locators that merely provide a link between the user's Web browser to Web servers hosting the URLs. They do not correspond to a resource locator returned from a lookup service that enables the client to dynamically locate executable code to facilitate access to a requested network service, as asserted by the Examiner.

Accordingly, *Hudtz et al.* and *Boutcher*, alone or in combination, fail to teach or suggest the recitations of claims 28, 37, 44-46, and 55, as asserted by the Examiner. Therefore, the cited art does not support the rejection of these claims under

35 U.S.C. § 103(a) as asserted by the Examiner should be withdrawn and the claims

allowed.

> b.   There is no Motivation to Combine the Cited Art to Teach or Suggest the
>   Recitations of Claims 28-33, 37-41, 43-51, and 53-61, as Asserted by
>   the Examiner

In addition to the arguments set forth above, *prima facie* obviousness has not

been established at least because there is no motivation to combine *Hudtz et al.* and

Boutcher. Determinations of obviousness must be supported by evidence in the record.

See In re Zurko, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (finding that the factual

determinations central to the issue of patentability, including conclusions of obviousness

by the Board, must be supported by "substantial evidence"). Further, the desire to

combine references must be proved with "substantial evidence" that is a result of a

"thorough and searching" factual inquiry. *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed.

Cir. 2002) (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52).

In this case, the Office Action does not show that a skilled artisan considering

Hudtz et al. and *Boutcher*, and not having the benefit of Applicants' disclosure, would

have been motivated to combine or modify the references in a manner resulting in

Applicants' claimed combination. In fact, the Examiner merely states a conclusion of

the alleged combination without providing the requisite motivation to support the

combination. The Examiner alleges that a skilled artisan would have modified *Boutcher*

"for the purpose of identifying a resource on the Internet and thus enabling the client to

access the resource." (*See Office Action*, page 5, lines 6-8.) This conclusion is not

properly supported and does not show that a skilled artisan would have modified the

reference as alleged. The mere fact that *Hudtz et al.* provides URLs does not show that a skilled artisan would have been motivated to modify *Boutcher* as alleged. Indeed, one of ordinary skill in the art would not have looked to a UPC matching system such as that taught by *Hudtz et al.* for modifications to a remote procedure call system, such as that taught by *Boutcher.*

The M.P.E.P. makes clear that: "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" M.P.E.P. § 2143.01 (citations omitted). The Examiner has not shown that the cited art "suggests the desirability" of the alleged combination. Indeed, there is no reason why a skilled artisan would look to modify *Boutcher* with the non-analogous teachings of *Hudtz et al.* According to *Boutcher,* there are three primary ways that a client can locate a server on a network. "First, the client can be explicitly told the name and/or address of the server . . . . Second, the client and server can locate each other via some broadcast mechanism. . . . Third, the client can look up the server in a some form of network directory." (*See Boutcher,* col. 10, lines 7-16.) According to *Boutcher,* the first two methods include situations where the client has little knowledge of the server, "other than its name and address." (*Id.,* col. 10, lines 17-19.) The third method enables the client to obtain additional information, such as interfaces and protocol information. (*Id.,* col. 10, lines 19-21.) Accordingly, *Boutcher* system operates in an environment where the client can already ascertain at least the server's name and address. Therefore, there is no need for *Boutcher* to be modified to include the URL retrieving processes of *Hudtz et al.* That is, one skilled in the art would not have been motivated to look to *Hudtz et al.* for modifying *Boutcher* because

Boutcher already has the ability to locate a server by at least its name or address (i.e., there is no need for a URL, much less one obtained from UPC labels).

Therefore the conclusions in the Office Action were not reached based on facts gleaned from the cited references and that, instead, teachings of the present application were improperly used in hindsight to reconstruct the prior art. For at least these additional reasons, the Examiner has not established a *prima facie* case of obviousness with respect to claims 28, 37, 44-46, and 55, and thus, the rejection of that claim under 35 U.S.C. § 103(a) should be withdrawn and the claims allowed.

Claims 29-33; 38-41, 43; 47-51, 53, and 54; and 56-61 depend from claims 28, 37, 46, and 55 respectively. As explained, the cited art does not support the rejection of claims 28, 37, 46, and 55. As such, the cited art does not support the rejection of claims 29-33; 38-41, 43; 47-51, 53, and 54; and 56-61 under 35 U.S.C. § 103(a) for at least the same reasons set forth in connection with the response to the rejection of claims 28, 37, 46, and 55. Accordingly, Applicants request the rejection of these claims be withdrawn and the claims allowed.

VI. The Rejection of Claims 34-36, 42, and 52 under 35 U.S.C. § 103(a)

In rejecting claim 34, the Examiner admits *Hudtz et al.* and *Boutcher* do not disclose returning smart proxy information to the client. (*See Office Action,* page 9, lines 12-13.) To address these deficiencies, the Examiner asserts *Hart* discloses these features. (*See Office Action,* page 9, lines 13-14.)

Claims 34-36, 42, and 52 depend from claims 28, 37, and 46, respectively. As explained, *Hudtz et al.* and *Boutcher* do not support the rejection of claims 28, 37, and 46. Further, *Hart* does not make up for the deficiencies of these references. Although *Hart* discloses a system for translating and executing non-native applications using stubs that contain software calls to facilitate the integration of non-native applications, the reference does not disclose returning smart proxy information to a client from a lookup service so that the client may dynamically load executable code to facilitate access to a network resource, as asserted by the Examiner. Therefore, the cited art does not support the rejection of claims 34-36, 42, and 52 under 35 U.S.C. § 103(a), and Applicants request the rejection of these claims be withdrawn and the claims allowed.

VII. Conclusion

In view of the foregoing remarks, Applicants submit that claims 28-88 are neither anticipated nor rendered obvious in view of the references cited against this application. Applicants therefore request reconsideration and reexamination of the application, and the timely allowance of the pending claims.
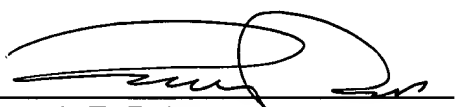
If there is any fee due in connection with the filing of this Preliminary

Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: June 20, 2005   By: _____

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